

## **REMARKS**

### **A. Summary of the Claims**

Claims 1-19, 40, and 41 are presently pending. In the Amendment filed on December 08, 2008 (the “Dec. 2008 Amendment”), Applicants (i) amended independent claim 1 to add additional claim elements, (ii) amended dependent claims 3, 5, 7, 9, 11, 13, 15, 17, and 19, and (iii) added new claims 40 and 41. The claim amendments submitted in the Dec. 2008 Amendment are reproduced on pages 2-5 of the present Response for convenience.

### **B. Summary of the Notice of Non-Compliant Amendment**

The Notice of Non-Compliant Amendment mailed on March 20, 2009 (“the Mar. 2009 Notice”) stated that “[t]he amendment filed on 12/08/08 is not fully responsive to the prior Office Action because...[c]laims 1-19, 40, and 41...are directed towards a non-elected invention (See 9/9/05 restriction).” (Mar. 2009 Notice, p. 2)

### **C. Summary of the Restriction Requirement mailed on September 09, 2005**

In the Restriction Requirement mailed on September 09, 2005 (“Sep. 2005 Restriction Requirement”), the Office: (1) restricted the claims to one of two inventions consisting of Group I corresponding to claims 1-31 and 39 and “drawn to a semiconductor device comprising RF isolation”; and Group II corresponding to claims 32-38 and “drawn to a process for preparing a semiconductor device that has RF isolation”; and (2) required Applicants to elect one of three species for examination if Applicants elected Group I, the three embodiments consisting of (i) Embodiment I corresponding to claims 1-19; (ii) Embodiment II corresponding to claims 20-31; and (iii) Embodiment III corresponding to claim 39. (Sep. 2005 Restriction Requirement, pp. 2-

3) The Sep. 2005 Restriction Requirement also acknowledged, and Applicants agree, that “**claim 1 is generic to claim 20.**” (p. 3 (emphasis added))

**C. Response to the Notice of Non-Compliant Amendment**

Applicants submit that the Dec. 2008 Amendment is responsive to the Non-Final Office Mailed on July 09, 2008 (“Jul. 2008 Office Action”), and Applicants respectfully request that the Office (i) withdraw the Mar. 2009 Notice; and (ii) enter the amendments presented in the Dec. 2008 Amendment (reproduced on pages 2-5 of this Reply). Applicants submit that the Dec. 2008 Amendment is responsive to the Jul. 2008 Office Action because instead of presenting new claims drawn to a non-elected invention, Applicants have merely added elements to generic claim 1, and thus, amended claim 1 is still within the scope of the original election.

Applicants acknowledge that “[a]n amendment canceling all claims drawn to [an] elected invention and presenting only claims drawn to [a] non-elected invention should not be entered, [and that] [s]uch an amendment is non-responsive.” MPEP 821.03. But that is not the case here. As acknowledged in the Sep. 2005 Restriction Requirement, “claim 1 is generic to claim 20.” (Sep. 2005 Restriction Requirement, p. 3) In the Dec. 2008 Amendment, Applicants did not cancel claim 1 and add claims directed to a non-elected invention. Instead, Applicants merely added additional elements to generic claim 1. Election of a generic claim should not preclude an Applicant from amending the generic claim to recite additional elements. *See* MPEP 821. Because Applicants did not present new claims drawn to a non-elected invention, Applicants submit that the Dec. 2008 Amendment is responsive to the Jul. 2008 Office Action, and that the Mar. 2009 Notice has been issued in error.

**D. Summary of Examiner Call on May 20, 2009**

On May 20, 2009, Applicants' Representative, Jeffrey Armstrong, telephoned Examiner Lewis to discuss the Mar. 2009 Notice. Applicant's Representative and the Examiner did not discuss the claims or the art cited against the claims, and Applicants' Representative and the Examiner did not reach any agreement regarding the claims. During the call, the Examiner agreed to review the Mar. 2009 Notice, the Dec. 2008 Amendment, and the Nov. 2005 Restriction Requirement, and the Examiner agreed to call Applicants' Representative during the week of May 25, 2009 to discuss this matter. Applicants thank the Examiner for agreeing to review and discuss this matter with Applicants' Representative.

**E. Conclusion**

In view of the foregoing, Applicants submit that the Dec. 2008 Amendment is responsive to the Jul. 2008 Office Action, and Applicants respectfully request that the Office (i) enter the amendments presented in the Dec. 2008 Amendment and (ii) withdraw the Mar. 2009 Notice.

Respectfully submitted,

McDonnell Boennen Hulbert & Berghoff LLP

Date: May 20, 2009

By: /Jeffrey P. Armstrong/  
Jeffrey P. Armstrong  
Reg. No. 54,967